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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,408	09/21/2000	Charles E. Roos	A32398-PCT-USA-066355.011	8750
21003	7590	01/05/2005	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COSIMANO, EDWARD R	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/667,408	ROOS, CHARLES E.	
	Examiner Edward R. Cosimano	Art Unit 3629	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 October 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) none is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2,4,5,7,10-18 and 21 is/are rejected.

7) Claim(s) 3,6,8,9,19 and 20 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 9/21/00 & 4/23/04 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

1. Applicant should note the changes to patent practice and procedure:
  - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
  - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
  - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. The finality of the Office action mailed 30 June 2004 is withdrawn in view of the following new rejections.
3. Applicant's claim for the benefit of an earlier filing date under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.
4. The proposed drawing correction filed 23 April 2004 has been approved.
- 4.1 Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings.

Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

6. Claims 7 & 10-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 In regard to claim 7, since:

A) the identified satellite location is not used in this claim, it is unclear why this satellite location is detected; and

B) location and time of an emergency condition has not been detected in this claim, it is unclear how this information could be communicated to the utility company.

6.2 In regard to claim 10, since the data port of claim 1 includes a “computer” and as recited in claim 10 the device includes a “computer” applicant’s reference to a computer at lines 3 and 5 of this claim is indefinite, vague and confusing.

6.3 In regard to claims 11 & 12, since one of ordinary skill would not recognize either:

A) the verifying of the data port (claim11); or

B) the verification that the data port initiated a transaction (claim 12);

as conducting a “secured financial transaction” as indicated in the preamble of these claims, these claims fail to particularly point out and distinctly claim the invention.

6.4 Claims 11-18 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) one of ordinary skill would not recognize either:

(1) the verifying of the data port (claim11); or

(2) the verification that the data port initiated a transaction (claim 12);

as conducting a “secured financial transaction” as indicated in the preamble of these claims, these claims fail to particularly point out and distinctly claim an invention that would accomplish the intended use of the claimed invention.

B) one of ordinary skill would not recognize either:

(1) the determination of a breach the data port interface and transmitting information if a breach has not been detected (claim 14);

as conducting a "secured computing" as indicated in the preamble of these claims, these claims fail to particularly point out and distinctly claim an invention that would accomplish the intended use of the claimed invention.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

6.5 Applicant's inclusion of the process claims 11-18, into machine/apparatus/device claim 1 by dependency creates an improper hybrid claim and hence the recited combination of claimed subject matter is confusing. This confusion occurs, since it can not be determined from the language of the final combined claim into which one of the statutory classes of invention the combined claim is to be classified as, that is either:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

6.6 In regard to claims 13 & 15-17, although one of ordinary skill at the time of the invention would have known how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

- A) in regard to claim 13, how it can be determined whether the vendor is or is not trustworthy, since this claim lacks sufficient information to make such a determination.

B) in regard to claims 15-17, it is unclear how the inputting step could be accomplished by "internet browsing" (claim 15), "telecommunications" (claim 16) or "video communications", since the inputting of claim 14 is from within the utility consumer's household and each of these methods of inputting data is from a source that is external to the utility consumer's household.

6.7 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

7.1 Claims 13 & 15-17 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), "We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

- a) obtaining the dimensions of said obstruction which affect the parameters of flow;
- b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;
- c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter
- d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;

and “Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

7.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims where not a process with in the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

7.1.3 As can be seen from claims 13 & 15-17, these claims are directed to a series of devices for performing various functions, which as set forth above in regard to the rejection of claims 13 & 15-17 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process with in the meaning of machine or process as used in 35 U.S.C. § 101.

7.2 Claims 1, 2, 4, 5, 7 & 10-18 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

- A) in regard to claims 7 & 10-18, these claims fail to comply with the requirements this title, namely 35 U.S.C. § 112 2<sup>nd</sup> paragraph as set forth above.
- B) in regard to claims 1, 2, 4, 5, 18 & 21, these claims fail to comply with the requirements this title, namely 35 U.S.C. § 103 as set forth below.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.1 Claims 1, 2, 4, 5, 18 & 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Karlsson et al (4,442,492) in view of Frew et al (4,803,632).

8.1.1 In regard to claims 1, 2, 4 & 5, Karlsson et al ('492) discloses a data port interface that is connected between a communications network, that is power lines R,S,T and an utility's user's household. Further, the data port of Karlsson et al ('492) includes computer 13 that as

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shown in fig. 2 is connected to the user's utility meter(s), including the user's power meter, in order to receive, monitor and store the measured amount of power and other utilities that have been delivered and consumed by the user. Data port computer 13 further receives instructions/commands from a central location 11 via modem 22 and power lines R,S,T, where these commands require the data port computer 13 to either:

- A) send collected consumption data from memory 15 to the central location 11;
- or
- B) use data received from central location 11 to change the information stored in memory 16 regarding the charges per unit of consumed power.

Computer 13 using the recorded amount of consumed utility in memory 15 and the associated cost data stored in memory 16 to process information for displaying on display 21 located at the consumer's location, where the displayed process information includes the cost per unit of consumed utility, the amount of consumed utility and the accumulated cost of the consumed utility.

8.1.2 The data port and consumption monitoring system of Karlsson et al ('492) does not disclose that the data port is located with in the utility meter's housing or that the display 21 is with in the consumer's household. However, as taught by Frew et al ('632) an user's utility meter 16, which is housed in base 18, includes a computer/processor 192 and displays 22 for display various types of information about the amount of consumed utilities. Further the system of Frew et al ('632) includes an programmer reader unit 42 that may request processor 192 to either:

- A) send collected consumption data from meter 16 to the central billing location 68; or
- B) use data received from central location 68 to change the information stored with meter 16 regarding the charges per unit of consumed power.

Processor 192 using the measured and recorded amount of consumed utility and the associated cost data stored in meter 16 to process information for displaying on displays 22 & 28 located at the consumer's location, where the displayed process information includes at least the cost per unit of consumed utility, the amount of consumed utility and the accumulated cost of the

consumed utility. Further the system of Frew et al ('632) includes a conveniently located remote display unit 26 with display 28 that:

- A) is connected to meter 16 via the consumer's house hold power distribution network; and
- B) mimics various types of information about the amount of consumed utilities as displayed on display 22,

so that the user may view utility consumption information from a single location without having to go to a number of different locations around the utility consumer's household.

8.1.3 Since, the system of Karlsson et al ('492) and the system of Frew et al ('632) perform the same function but have different structures, that is:

- A) the system of Karlsson et al ('492) uses a processor that is located at the user's location and is external to the utility meter's housing to receive, send and process utility information; and
- B) the system of Frew et al ('632) uses a processor that is located at the user's location and is internal to the utility meter's housing to receive, send and process utility information;

it would have been obvious to one of ordinary skill at the time of the invention that the separate processor of Karlsson et al ('492) could be located at any suitable location, for example within the housing of the power meter as taught by Frew et al ('632), because:

- A) the Court has stated it is not invention to merely move the location of a device, since the new position does not affect, i.e. modify the operation of the device, (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)); and
- B) the Court has stated it is not invention to merely make various parts separable without unexpected results if access to something is desirable, (In re Dulberg, 129 U.S.P.Q. 348 @ 349 (CCPA, 1965)); or
- C) the Court has stated it is not invention to merely make various parts integral without unexpected results, (In re Larson et al, 144 U.S.P.Q. 347 @ 349 (CCPA, 1965)).

8.1.4 In regard to the location of the displayed information, since the information on the cost per unit of utility, the amount of consumed utility and the total cost of the consumed utility is information that would be of interest to the consumer, it would have been obvious to one of ordinary skill at the time of the invention that display 21 of Karlsson et al ('492) could be located at any suitable location for the consumer, for example within the consumer's household as taught by Frew et al ('632).

8.1.5 In regard to claims 18 & 21, either Karlsson et al ('492) or Frew et al ('632) disclose that a wireless communications link may be used to transmit and receive information/data.

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

- A) in regard to claim 3, the prior art does not teach or suggest the use of a "voice processor" in the data port.
- B) in regard to claim 6, the storing and retrieval of digitized voice messages that sent tot eh telephone when a power outage is detected.
- C) in regard to claim 7, the communicating of the time of an emergency condition to the utility company when a power outage is detected.
- D) in regard to claim 8, the prior art does not teach or suggest the use of a "video processor" in the data port.
- E) in regard to claim 9, the prior art does not teach or suggest the modification of the settings of a internal thermostatic device as a function of the cost of available power.
- F) in regard to claim 10, the prior art does not teach or suggest the relaying of messages from the utility company through the data port to the internal device.
- G) in regard to claims 11-13, the prior art does not teach or suggest using the data port to conduct a secure transaction.
- H) in regard to claims 14-17, the prior art does not teach or suggest detecting breaches in the data port interface be for transmitting information to the external network.
- I) in regard to claim 19, the prior art does not teach or suggest including a "descrambler" in the data port interface with the utility meter's housing.

J) in regard to claim 19, the prior art does not teach or suggest including a "router" in the data port interface with the utility meter's housing.

10. Response to applicant's arguments.

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

11. Claims 3, 6, 8, 9, 19 & 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11.1 Claims 7, 10-12 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/22/04

  
Edward R. Cosimano  
Primary Examiner A.U. 3629